

REMARKS

Claims 1, 2, 4, 6, 7, 9 and 11-13 are pending in the above-identified application. Support for the changes to claims 1, 6 and 13 is based on the disclosure of embodiments of the present invention including a core diameter of 41.2 mm (page 18, line 8 of the specification) and a golf ball diameter of 42.8 mm (cf. page 19, line 8 of the specification) with the use of the following calculation: $(42.8 - 41.2) \times 1/2$.

Request that Changes to Claims be Entered of Record

It is respectfully requested that the changes to the above claims be entered of record for the following reasons. First, it is noted that the Examiner suggested these changes at the Interview of September 1, 2009 (discussed on more detail below), and indicated that he would indeed enter these changes. Second, these changes overcome the rejection under 35 USC 112, first paragraph, as noted below so as to reduce issues and comply with requirements of form. Third, no new claims or issues are being introduce. Thus, these changes comply with 35 USC 1.116(b) and should be entered of record and considered by the Examiner.

Interview of September 1, 2009 with Examiner

Applicant appreciates the Examiner taking time to conduct the Interview of September 1, 2009. The claim changes suggested by the Examiner have been made as noted above, such that it appears the rejection under 35 USC 112, first paragraph, should be withdrawn. Regarding the rejection under 35 USC 103(a) discussed in detail below, it was emphasized at the Interview that the present claims now recite a cover thickness much thinner than suggested by the cited references, such that the combination of this distinction together with the other distinctions noted below, including the unexpected advantages exhibited by the claimed invention, provides ample support to the patentability of the present claims such that the present application should be placed into allowable form.

Issues under 35 USC 103(a)

Claims 1, 2, 4, 6, 7, 9 and 11-13 have been rejected under 35 USC 103(a) as being unpatentable over Wu '358 (US 5,908,358) in view of Iwami '824 (JP 2002-07824). This rejection is traversed based on the following reasons.

Distinctions over Cited References

The present invention is directed to a golf ball which has, among other features, a cover with a thickness of 0.2 to 0.8 mm as recited in present claims. As explained in the present specification at page 10, lines 2-9, the golf ball of the present invention employs a cover having a thickness which is less than conventional golf ball covers which typically have a golf ball cover thickness of 1.5 mm or greater. Employment of such a thin cover advantageously prevents the resilience from being lowered since a relatively soft polyurethane cover is employed. Also, employment of this thin cover in combination with the stiffness modulus and hardness ranges provides for unexpectedly improved properties as evidenced by the comparative test results summarized at pages 15-27 of the present specification. Note especially Examples 1-7 (present invention) in Table 2 exhibit advantageously improved carry, abrasion resistance, controllability, and/or shot feeling properties when compared to Examples 8-15 in Table 3 which are golf balls that do not satisfy the stiffness modulus and hardness property requirements of the present invention. Also note that *all* of the tested golf balls 1-15 had a cover thickness of about 0.8 mm. Consequently, this is evidence that embodiments of the present invention, including a very thin cover thickness of about 0.8 mm, exhibit unexpected, advantageous properties.

In addition to the above, it is respectfully submitted that the Board of Patent Appeals Decision of October 1, 2008 reversed the previous rejection by the Examiner under 35 USC 103(a) of appealed claims 14-16 which recited the feature of a cover thickness of 0.2-1.5 mm. Claims 14-16 have now been inserted into independent claims 1, 6 and 13, and this cover thickness range has been narrowed to match the comparative test results discussed above. It is submitted that the thin cover thickness feature, in combination with the other stiffness and hardness features, was previously recognized as being patentable by the Board, and that now the presently amended claims recite a narrower cover thickness range which supports an even

greater distinction over the cited references. Therefore, it is requested that the Board Decision be followed and that the present claims be placed into allowable form.

Wu '358, as noted in the Office Action of December 16, 2008, discloses examples of golf balls in Table 1 at columns 7-8 which have covers that are about 1.27 mm in thickness or greater. Wu '358 fails to disclose any suggestion or basis for a motivation to one skilled in the art to modify the golf ball cover thicknesses of the described embodiments so as to be reduced and fall within the presently claimed cover thickness range having a maximum thickness of 0.8 mm as in the present invention. Wu '358 also fails to recognize the unexpected, advantageous properties exhibited by the golf balls of the present invention having a cover thickness of approximately 0.8 mm as evidenced by the comparative test results discussed above. Further, it does not appear from the machine translation of Iwami '824 that any particular golf ball cover thickness is described, such that Iwami '824 fails to make up for these deficiencies noted with respect to Wu '358. In this regard, note that employment of the thin cover in the golf ball of the present invention, wherein the polyurethane cover is thinner than a convention cover, unexpectedly does not lower resilience as noted at page 10, lines 6-9 of the present specification, a result completely unrecognized by and which would not occur with the hypothetical combination of cover of Wu '358 with the composition of Iwami '824. In addition, even assuming that *prima facie* obviousness has been properly alleged, such obviousness has been rebutted by the evidence of unexpected, advantageous properties for golf balls having a thin cover thickness of about 0.8 mm. Accordingly, it is submitted that significant patentable distinctions exist between the present claims and both the Wu '58 and Iwami '824 references, whether these references are taken separately or hypothetically combined.

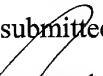
It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 30, 2009

Respectfully submitted,

By 
Andrew D. Meikle
Registration No.: 32,868
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant